

### **REMARKS**

No claims are amended, claims 31-60 and 62 are canceled, and no claims are added; as a result, claims 1-30 and 61 are now pending in this application.

#### **Specification Amendment**

Applicants have amended the specification to correct obvious typographical errors in the application. Specifically, an amendment was made on page 10 of the specification to correct the reference number for the database server from "150" to "190." An amendment was made on page 11 of the specification to delete the phrase "191." No new matter is proposed. Approval and entry of the specification amendments is respectfully requested.

#### **Information Disclosure Statement**

Applicants thank the Examiner for returning a signed copy of Form 1449 filed on May 25, 2005.

#### **Interview Summary**

In response to the telephonic Interview Summary of May 23, 2005, Applicants concur that an agreement was met that the Examiner would send an Office Action on 6/2/05 to answer the 8/12/04 amendment and that a supplemental IDS would be included. Both were received on 6/12/05.

#### **§103 Rejection of the Claims**

##### **§103 Rejection of the Claims 1-2, 10-11, 13, 19, 24-25, and 61**

Claims 1-2, 10-11, 13, 19, 24-25, and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. 4,931,929) in view of Halliday et al. (U.S. 5,880,740).

**The proposed combination of Sherman with Halliday et al. fails to teach or suggest all of the elements of claims 1-2, 10-11, 13, 19, 24-25, and 61.**

By way of example and not by way of limitation, claims 1 and 61 both recite, generating a user interface that facilitates input of specification

information concerning the promotional product, the specification information including product information identifying a base product to be decorated and decoration manufacturing process information identifying a process whereby a decoration is applied to the base product; receiving the specification information concerning the promotional product. [Emphasis added].

In contrast, Sherman at column 8, lines 40-43 states, "a user of the present inventive system specifies a product type and is then provided with a list of predetermined categories of characteristics for that product type. The user then selects one or more desired characteristics." However, characteristics in Sherman are described in column 7, line 67 through column 8, line 12 as:

Each record of this database identifies a plurality of characteristics of the corresponding design component product. Products are grouped into files by type, such as chairs, carpets, or wallcovering, and all products within a given type are described within their corresponding records by a common group of categories of characteristics. Products of a different type may be described by different categories. For instance, paint is described by liquid volume whereas furniture can be described by height, width and depth. However, all products, regardless of type, share at least four common categories of characteristics: price, manufacturer, color and a location of the design component image within an image database.

Thus, there is no teaching or suggestion of a user interface that facilitates input of specification information including product information identifying a base product and decorating manufacturing process information identifying a process whereby a decoration is applied to the base product. Thus, Sherman fails to teach or suggest all of the elements recited in claims 1 and 61.

The Office Action on page 3 states that these elements are "merely non-functional descriptive material that do not contribute to a claimed step in pricing a product." Applicants respectfully disagree. The recitation of product information identifying a base product to be decorated and decoration manufacturing process information identifying a process whereby a decoration is applied to the base product represent types of specific information, the input of which is facilitated by a user interface, and therefore are elements included in claims 1 and 61 that are not recited in Sherman.

Further, claims 1 and 61 both recite, "automatically calculating a price for the promotional product utilizing the product information and the decoration manufacturing process information." Since Sherman fails to teach or suggest decoration manufacturing process information, it follows that Sherman also fails to teach or suggest automatically calculating a price for the promotional product utilizing the decorating manufacturing process information, as recited in claims 1 and 61. With respect to these elements, the Office Action on page 4 states these elements are, "merely non-functional descriptive material that do not distinguish from prior art because they do not contribute to core steps of pricing a product, including decoration charges as extra optional practices." [Emphasis added]. Again, Applicants respectfully disagree with these statements, and further, submit that "contribution to core steps" is not the proper standard by which the obviousness of a claim is determined.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The M.P.E.P. contains explicit direction to the Examiner for establishing a *prima facie* case of obviousness, wherein M.P.E.P. § 2142 states,

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). [Emphasis added].

Here, the Office Action fails to point out in Sherman a teaching or suggestion of all of the claim limitations recited in claims 1 and 61. In fact, the Office Action on page 4 admits that Sherman fails to disclose automatically calculating a unit price for the promotional product utilizing the product/pattern information and decoration manufacturing process information, but relies on Halliday et al. as providing these elements admittedly missing from Sherman. However, Halliday et al. at column 7, lines 15-23 merely states,

The workstation 101 consists of a conventional personal computer 111 provided with local read/write disk storage, such as a hard disk drive, at 113 and a CD-ROM player 115, both of which store individual image

elements used to form composite images. A mouse 117 is connected to provide positional, zone selecting input signals to the computer 111 which displays the composite images on a conventional CRT display device 121. A keyboard 123 is used to accept text input and command from the user.

Applicants' representatives cannot find, and the Office Action does not point out in Halliday et al., a teaching or suggestion of a user interface that facilitates input of specification information including decorating manufacturing process information identifying a process whereby a decoration is applied to the base product, as recited in claims 1 and 61. Further, it logically follows that there is no teaching or suggestion in Halliday et al. of "automatically calculating a price for the promotional product utilizing the product information and the decoration manufacturing process information," as also recited in claims 1 and 61. In fact, Applicants' representatives can not find a teaching or suggestion in Halliday et al. of calculating a price whatsoever, as suggested in the Office Action.

Thus, because neither Sherman nor Halliday et al., either alone or in combination, teach or suggest all of the elements recited in claims 1 and 61, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 1 and 61. Claims 2, 10-11, 13, 19, and 24-25 depend from claim 1, and therefore include all of the elements recited in claim 1. For reasons analogous to those stated above with regards to claim 1, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 2, 10-11, 13, 19, 24-25.

For at least the reasons stated above, Applicants respectfully request the withdrawal of the rejection of claims 1-2, 10-11, 13, 19, 24-25, and 61, and reconsideration and allowance of all claims now pending in the application.

§103 Rejections of the Claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29 and 30

Claims 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. 4,931,929) in view of Halliday et al. (U.S. 5,880,740) in view of Goldberg et al. (U.S. Pat. 6,196,146), and in view of Mikurak (U.S. Pat. 6,606,744).

Claims 8-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. 4,931,929) in view of Halliday et al. (U.S. 5,880,740) further in view of Schwab (U.S. Pat. 6,226,412).

Claims 3-7, 10, 12, 14-18, 20-23, 26, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. 4,931,929) in view of Halliday et al. (U.S. 5,880,740) further in view of Goldberg et al. (U.S. Pat. 6,196,146).

*The proposed combinations of references fail to teach or suggest all of the elements of claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30.*

Claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30 have been rejected based on the various combinations of references as stated above. Each of these claims depend from claim 1 of the application, and therefore include all of the elements recited in claim 1. In each of the above rejections, the Office Action relies on the rationales and references in rejecting claim 1, specifically the proposed combination of Sherman and Halliday et al., as supplying the elements recited in claim 1. Applicants believe they have established that the proposed combination of Sherman and Halliday et al. does not teach or suggest all of the elements recited in claim 1. Further, the Office Action fails to point out in any of the other cited references where the elements recited in claim 1 and missing from Sherman and Halliday et al. are taught or suggested in any of these other references. Therefore, each of the proposed combinations of references fails to teach or suggest all of the elements recited in claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30, as the proposed combinations of references are applied to these claims. Since each of the proposed combinations of references fails to teach or suggest all of the elements recited in claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30 as the rejections are applied to the claims, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30.

For at least the reasons stated above, Applicants respectfully request the withdrawal of the rejections of claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30, and reconsideration and allowance of all claims now pending in the application.

*Reservation of Rights*

Applicants do not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

CONCLUSION

Applicants respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date 10/06/05

By 

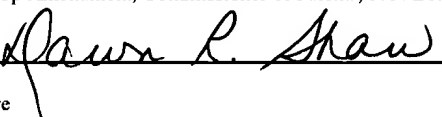
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6 day of October, 2005.

Dawn R. Shaw

Name



Signature